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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,905	05/04/2001	David Alan Witt	13946(END-696)	9106

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EXAMINER
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FERKO, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 07/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/849,905

Applicant(s)

WITT ET AL.

Examiner

Kathryn Ferko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: an "end effector." The specification does not adequately disclose an end effector or what elements would constitute an end effector. Therefore, it is unclear as to the scope of the term "end effector." Any art rejections will be as best understood.
3. Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: stub shaft. The specification does not recite and the drawings do not depict a stub shaft. Any art rejections are as best understood.
4. Claim 12 recites the limitation "said cam means" in line 2. There is insufficient antecedent basis for this limitation in the claim. There has been no prior recitation of "cam means."

### ***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 5, 7-12, and 14 rejected under 35 U.S.C. 102(b) as being anticipated by Mastri et al. in US Patent No. 6,024,750.

Mastri et al. discloses an ultrasonic surgical instrument having an end effector including blade (58, 59) and clamp means (60) for the engagement of tissues located therebetween, as recited in column 3, lines 35-67 and seen in figures 3 and 4; an elongated shaft element (such as 50) having the end effector arranged at a first end thereof; an elongated tubular member (such as 46) extending about the elongated shaft element in coaxial relationship, the clamp means (60) being movable relative to the blade (58,59) and the tubular member (46), the elongated tubular member (46) having a first end in operative engagement with the end effector, as recited in column 3, lines 35-67, column 4 and seen in figure 4; a handle portion (generally at 22b, 22a, and 36) for receiving second opposite ends of respectively the elongated shaft element (50) and the elongated tubular member (46), the handle portion including finger-actuable scissors-like thumb and finger ring structure for imparting axial displacement between the elongated shaft element and the elongated tubular member, the tubular member biasing the clamp means so as to cause the blade and clamp means to selective open and close relative to each other; as recited in

column 4, lines 45-67, column 5, lines 1-34 and seen in figures 5-7; an elongated tubular member (46) that has the second end thereof slidably journaled in the handle portion (generally at 22b, 22a, and 36), the elongated shaft element (50) being fixedly attached to the handle portion, the thumb and finger ring assembly having a pivotable portion operatively connected with the second end of the elongated tubular member, whereby actuation of the pivotable portion imparts the axial displacement to the elongated tubular member (46) relative to the elongated shaft element (50), as recited in column 4, lines 45-67, column 5, lines 1-34 and seen in figures 5-7; a first end of the elongated shaft element (50) and of the elongated tubular member (46) that have a cooperative camming structure for selectively opening and closing the blade and clamp means responsive to relative axial movement between the shaft element (50) and tubular member (46), as recited in column 3, lines 34-67, column 4, column 5, lines 1-34 and seen in figures 3-7; a blade (58, 59) of the end effector that has a coaxial tip on the elongated shaft element (50), as seen in figure 4; a blade (58, 59) that has a stub shaft integrally formed at the first end of the elongated shaft element (50), whereby the shaft element forms an ultrasonic blade extender, as seen in figure 4; a blade that has a stub shaft which is detachably (via 56 with 58) fastened to the first end of the elongated shaft element, whereby the shaft element forms an ultrasonic blade extender, as seen in figure 4; a blade (58, 59) that is fastened to the elongated shaft element (50) through a screw threaded connection (via 56 with 58), as seen in figure 4; cam means having a cam arm mounted on the

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blade for pivotal movement relative thereto; as recited in columns 3-5 and seen in figures 3-7; and a plurality of axially spaced silastic rings (51) that are formed at nodes along the length of the elongated shaft element (50) and blade so as to prevent dispersion of ultrasonic waves to the surrounding elongated tubular member during operation of the instrument, as recited in column 3, lines 45-60.

2. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(a and/or e) as being anticipated by Miyawaki et al. in US Patent No. 6,193,709.

Miyawaki et al. discloses an ultrasonic surgical instrument having an end effector including blade (251a) and clamp means (282) for the engagement of tissues located therebetween; an elongated shaft element (252) having the end effector arranged at a first end thereof; an elongated tubular member (231) extending about the elongated shaft element (252) in coaxial relationship, the clamp means (282) being movable relative to the blade (251a) and the tubular member (231), the elongated tubular member (231) having a first end in operative engagement with the end effector; a handle portion (213, 214) for receiving second opposite ends of respectively the elongated shaft element (252) and the elongated tubular member (231), the handle portion (213, 214) including finger-actuable scissors-like thumb and finger ring structure for imparting axial displacement between the elongated shaft element (252) and the elongated tubular member (231), the tubular member biasing the clamp means (282) so as to cause the blade (251a) and clamp means (282) to selective open and close relative to each other, as recited in columns 12-24 and seen in figures 13 and 21;

an elongated tubular member (231) that is fixedly attached to the handle portion (213, 214), the thumb and finger ring structure having a pivotable portion hingedly connected to the second end of the elongated shaft element, whereby actuation of the pivotable portion imparts the axial displacement to the elongated shaft element relative to the elongated tubular member, as seen in figures 13 and 21; a pivotable portion is that rotatable about a pivot boss fixed to a stationary part of the handle portion, as recited in columns 13 and 14; an insertion arm on the pivotable portion is operatively engaged with the elongated shaft element for imparting axial movement thereto responsive to rotation of the pivotable portion about the pivot surfaces, as recited in column 13, lines 40-67; and a first end of the elongated shaft element and of the elongated tubular member that have cooperative camming structures for selectively opening and closing the blade and clamp means responsive to relative axial movement between the shaft element and tubular member, as recited in column 13, lines 40-67.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mastri et al. in US Patent No. 6,024,750.

Mastri et al. disclose the invention with the exception of a pivotable portion including an actuating extension engageable into an aperture in the elongated tubular member for imparting axial displacement thereto responsive to rotational movement of the pivotable portion; a handle portion that includes latching pushbutton means for release of the blade and clamp assembly; and spring limiter means that are formed on the elongated tubular member so as to absorb excessive operating forces and stresses generated responsive to actuation of the handle portion.

On the other hand, Mastri et al. disclose a pivotable portion including an actuating extension engageable into an annular flange (48) in the elongated tubular member for imparting axial displacement thereto responsive to rotational movement of the pivotable portion. Since the current specification does not recite the criticality of an aperture, the annular flange of Mastri et al. can be considered equivalents since the same function is achieved. Therefore, it would be obvious to one with ordinary skill in the art to modify the invention of Mastri et al. to include a protruding portion to engage with an aperture in the elongated tubular member.

Further, a handle portion that includes latching pushbutton means for release of the blade and clamp assembly and spring limiter means that are formed on the elongated tubular member so as to absorb excessive operating forces and stresses generated responsive to actuation of the handle portion are



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within the scope of that disclosed by Mastri et al. and would be obvious to one with ordinary skill in the art.

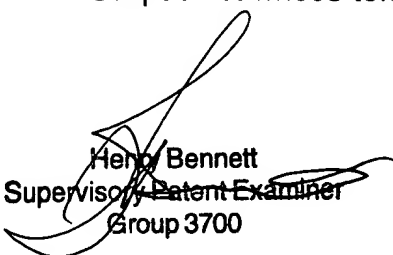
***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: US 2002/0002378; US 2002/0019646; US 2002/0183774; US Patent No. 6,569,178; US Patent No. 6,458,142; US Patent No. 6,358,264; US Patent No. 6,165,191; US Patent No. 6,129,735; US Patent No. 6,063,098; US Patent No. 6,056,735.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Ferko whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
Henry A Bennett  
Supervisory Patent Examiner  
Group 3700

KF  
June 26, 2003